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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,485	01/28/2002	Tetsuya Kusagawa	0445-0317P	5643
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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER REICHLE, KARIN M	
			ART UNIT 3761	PAPER NUMBER

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/056,485	KUSAGAWA ET AL.	
	Examiner	Art Unit	
	Karin M. Reichle	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) 4,6-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 4, 6-9 and 11 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Language Interpretation

2. The term “upstanding” is defined by the American Heritage Dictionary as “standing erect or upright.” Applicants do not specifically define the term “connects”. Therefore such term is given its common, i.e. dictionary, definition, i.e. includes both direct and indirect connections.

Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mizutani et al ‘140.

Claim 1: See Figures 1-3, i.e. the oblong absorbent article is 1, the absorbing layer is 12, the leak proof layer is 11, the standing gathers are 5. The gathers 5, see, e.g., col. 5, lines 54-58, include an “upstanding” portion, see Claim Interpretation Section supra (Note the claim language does not require the upright portion to be linearly upright) and element 15, which extends between a portion near an adjacent longer side edge of the absorbing layer and a portion 16

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which portion is elastically extensible, see col. 6, lines 24-39, is substantially parallel to the absorbing layer and comes into planar contact with a wearer's skin when worn, see, e.g., col. 5, lines 55-58, col. 8, lines 35-45 and col. 10, lines 13-20, i.e. is maintained in steric shape, i.e. the skin contacting portion 16 is maintained planar. As set forth at, e.g., col. 5, lines 30-57 and col. 6, lines 25-58, col. 7, lines 58-62, col. 7, line 60-col. 8, line 4, col. 8, lines 18-24, the portion 16 is disclosed as being made of a sheet 20 and at least one elastic member 7 which is fixed to the sheet discretely at 20b in the longitudinal direction thereof while in a stretched state and the parts of the sheet where the elastic member is not fixed are raised by contraction of the elastic member to form a plurality of hollow ridges 20a parallel to each other on a side of the skin contactable portion across the width of the portion 16, i.e. in a linear manner along the contraction direction of the elastic member and extending across the contraction direction of the member.

Claim 1 now requires, as best understood, that the sheet not only be planar but also unstretched when it is fixed to the elastic member and that it be adhesively fixed to the elastic member. It is noted that it is the Examiner's position that the limitation of transverse discrete fixation was previously required on lines 9 et seq of the claim prior to the most recent amendment. However claim 1, lines 9-17 of claim 1 still recite a product by process. As set forth in MPEP 2113, determination of patentability is based on the product of a product by process claim not on the method of production. If the product in the product by process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The end product of the claim is a contracted elastic member discretely and adhesively fixed to the sheet and a plurality of hollow ridges parallel to each other and perpendicular to the elastic between the points of adhesive fixation, i.e.

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the valleys of the ridges are bonded to the elastic member. It is also noted that the claim language does not require any specific density or lack thereof in any specific portion. See col. 6, lines 7-9 and 25-39, col. 7, line 56-col. 8, line 4 of Mizutani, i.e. a contracted elastic member discretely and adhesively fixed to the sheet and a plurality of hollow ridges parallel to each other and perpendicular to the elastic between the points of adhesive fixation, i.e. the valleys of the ridges are bonded to the elastic member. Therefore, the end product of Mizutani and the end product of the claim appear to be the same or similar, i.e. “obvious”, even though they are produced by different processes and therefore the product of the instant claims does not patentably distinguish over the product of Mizutani.

Claim 10: This claim recites capability, function or property of the structure claimed in claim 1, i.e. no additional structure is claimed. The Mizutani et al device includes all the claimed structure. Therefore, there is sufficient factual evidence to reasonably conclude that the capability, function or property would also be inherent in the same structure of Mizutani et al. See MPEP 2112.01.

Claim Rejections - 35 USC § 103

5. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor '972 in view of Boberg '398 and Correa et al '386.

Claim 1: See Figures, i.e. the oblong absorbent article is 10, the absorbing layer is 20, the leak proof layer is 22, the standing gathers are 12. The gathers 12, see, e.g., abstract, include an “upstanding” portion, see Claim Interpretation Section supra (Note the claim language does not require the upright portion to be linearly upright) and element 36, which extends between a

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portion near an adjacent longer side edge of the absorbing layer and a portion 40 which portion is elastically extensible, see paragraph bridging pages 9-10, is substantially parallel to the absorbing layer and comes into planar contact with a wearer's skin when worn, see, e.g., page 10, lines 2-3, i.e. the skin contacting portion 40 is maintained planar. As also set forth in the paragraph bridging pages 9-10, the portion 40 is disclosed as being made of a sheet, e.g. 18, and at least one elastic member 48 which is fixed to the flattened, i.e. planar, sheet in the longitudinal direction thereof while the elastic member 48 is in a stretched state and parts of the portion 40 are raised by contraction of the elastic member to form a plurality of ridges parallel to each other on a side of the skin contactable portion across the width of the portion 40, i.e. in a linear manner along the contraction direction of the elastic member and extending across the contraction direction of the member, see Figures. Again, it is noted that it is the Examiner's position that the limitation of transverse discrete fixation was previously required on lines 9 et seq of the claim prior to the most recent amendment. Therefore, the Taylor device clearly includes all the claimed structure except for the elastic member additionally being 1) discretely and adhesively attached to the sheet such that the ridges formed thereby are hollow upon contraction of the elastics and 2) being attached to the sheet in while it is unstretched. With regard to 1) While page 9, lines 1-3 of Taylor teach adhesive attachment, the reference is silent as to whether the elastics are continuously or discontinuously, i.e. discretely, attached to the sheet to form the ridges seen in the Figures. However, see Boberg '398 at, e.g., page 14, lines 16-32 which teaches discontinuous or discrete attachment of elastic members to a sheet is interchangeable with continuous attachment and Correa et al '386 at, e.g., Figures 1a and 2a and the paragraph bridging cols. 7-8 which teaches a pad attaining a curved shaped due to elastics attached by

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discrete attachment to a sheet such that when the elastics are contracted to form the curved shape the ridges which are formed are hollow. Therefore to make the attachment of the elastic 48 to the sheet 18 of Taylor discrete attachment (if not already) would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Boberg et al. In so doing, the resultant ridges of the modified Taylor device would be hollow as taught or evidenced by Correa et al. With regard to 2), Taylor does not clearly state that the sheet is unstretched in the disclosed flattened condition. However, even if it is not, again claim 1, lines 9-17 of claim 1 still recite a product by process. As set forth in MPEP 2113, determination of patentability is based on the product of a product by process claim not on the method of production. If the product in the product by process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The end product of the claim is a contracted elastic member discretely and adhesively fixed to the sheet and a plurality of hollow ridges parallel to each other and perpendicular to the elastic between the points of adhesive fixation, i.e. the valleys of the ridges are bonded to the elastic member. It is also noted that the claim language does not require any specific density or lack thereof in any specific portion. The prior art combination of Taylor, Boberg and Correa also teaches a contracted elastic member discretely and adhesively fixed to the sheet and a plurality of hollow ridges parallel to each other and perpendicular to the elastic between the points of adhesive fixation, i.e. the valleys of the ridges are bonded to the elastic member. Therefore, the end product of the prior art and the end product of the claim appear to be the same or similar, i.e. "obvious", even though they are produced by different processes and therefore the product of the instant claims does not patentably distinguish over the prior art product.

Claim 10: see page 8, lines 2-7.

6. Claims 1, 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto '247 in view of Boberg '398 and Correa et al '386.

Claim 1: See Figures, i.e. the oblong absorbent article is 20, the absorbing layer is 34, the leak proof layer is 32, the standing gathers are 44. The gathers 44, see, e.g., paragraph 32, include an "upstanding" portion 68, see Claim Interpretation Section supra (Note the claim language does not require the upright portion to be linearly upright), which extends between a portion near an adjacent longer side edge of the absorbing layer and a portion 70 which portion is elastically extensible, see paragraphs 41-43, is substantially parallel to the absorbing layer, see, e.g., Figure 2, and comes into planar contact with a wearer's skin when worn, see, e.g., paragraph 48, i.e. the skin contacting portion 70 is maintained planar when contacting. As also set forth in the paragraphs 45-46, the portion 70 is disclosed as being made of a planar sheet, e.g. 76, and at least one elastic member 46 which is fixed to the sheet in the longitudinal direction thereof while in a stretched state and parts of the portion 70 are raised by contraction of the elastic member to form a plurality of ridges parallel to each other on a side of the skin contactable portion across the width of the portion 70, i.e. in a linear manner along the contraction direction of the elastic member and extending across the contraction direction of the member, see Figures 1 and 22. Therefore, the Miyamoto device clearly includes all the claimed structure except for the elastic member additionally being 1) discretely and adhesively attached to the sheet such that the ridges formed thereby are hollow upon contraction of the elastics and 2) being attached to the sheet in while it is unstretched. With regard to 1) while the cited portions of Miyamoto teach adhesive attachment, the reference is silent as to whether the elastics are

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continuously or discontinuously, i.e. discretely, attached to the sheet to form the ridges seen in the Figures. However, see Boberg '398 at, e.g., page 14, lines 16-32 which teaches discontinuous or discrete attachment of elastic members to a sheet is interchangeable with continuous attachment and Correa et al '386 at, e.g., Figures 1a and 2a and the paragraph bridging cols. 7-8 which teaches a pad attaining a curved shaped due to elastics attached by discrete attachment to a sheet such that when the elastics are contracted to form the curved shape the ridges which are formed are hollow. Therefore to make the attachment of the elastic 46 to the sheet 76 of Miyamoto discrete attachment (if not already) would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Boberg et al. In so doing, the resultant ridges of the modified Taylor device would be hollow as taught or evidenced by Correa et al. With regard to 2), Miyamoto does not clearly state that the sheet is unstretched in the disclosed planar condition. However, even if its not, again claim 1, lines 9-17 of claim 1 still recite a product by process. As set forth in MPEP 2113, determination of patentability is based on the product of a product by process claim not on the method of production. If the product in the product by process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The end product of the claim is a contracted elastic member discretely and adhesively fixed to the sheet and a plurality of hollow ridges parallel to each other and perpendicular to the elastic between the points of adhesive fixation, i.e. the valleys of the ridges are bonded to the elastic member. It is also noted that the claim language does not require any specific density or lack thereof in any specific portion. The prior art combination of Miyamoto, Bomberg and Correa also teaches a contracted elastic member discretely and adhesively fixed to the sheet and a plurality of hollow

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ridges parallel to each other and perpendicular to the elastic between the points of adhesive fixation, i.e. the valleys of the ridges are bonded to the elastic member. Therefore, the end product of the prior art and the end product of the claim appear to be the same or similar, i.e. “obvious”, even though they are produced by different processes and therefore the product of the instant claims does not patentably distinguish over the prior art product.

Claim 3: The portion 68 connects directly to a middle in a width direction of said elastically extensible portion 70, see Figures.

Claim 10: See paragraph 30, i.e. can be an absorbent article, i.e. insert, i.e. insertable into something else, which is placed against or in proximity to the body to absorb and contain exudates discharged therefrom. “Fix” as defined by the dictionary is “to place or fasten securely”. Miyamoto does not clearly indicate whether the insert is placeable, i.e. insertable, securely in or fastenable to and undergarment during use. However, it is well known to fix absorbent inserts to underwear in use, i.e. they are “fixable” to underwear in use, so that they are in proximity to the body and can absorb and contain fluids discharged therefrom. See, e.g., Correa at col. 1, lines 64-66. Therefore, to make the Miyamoto insert “fixable” to an undergarment in use, if not already, would be obvious to one of ordinary skill in the art in view of the recognition that such would enable the insert to be held in proximity to the body so that it absorb and contain fluids discharged therefrom and the desire of Miyamoto to so.

7. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Response to Arguments

8. Applicants remarks with regard to form have been considered but are deemed moot in that the issues addressed have not been reraised. Applicant's remarks with respect to the art have been considered but are deemed not persuasive for the reasons set forth supra, i.e. narrower than the claim language and the teachings of the prior art.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other published applications also show features of the claimed invention.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

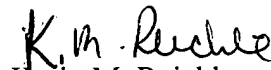
Any new grounds of rejection were necessitated by the claim language added to the last section of claim 3 and line 10 of claim 1.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
March 16, 2005